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REMARKS

The present invention relates to an improved polishing pad suitable for chemical mechanical planarization (CMP). Claims 1-51 are currently pending.

The Office Action has required restriction to one of the following inventions under 35 U.S.C. 121:

- I. Claims 1-33, drawn to a polishing pad, classified in class 451, subclass 41.
- II. Claims 34-51, drawn to a method, classified in class 451, subclass 28.

The Office Action states that the above identified inventions are related as process and apparatus for its practice. The Office Action asserts that the apparatus in this invention can be used to practice another and materially different process such as one that requires gas filled pores or no pores.

The applicants hereby elect, with traverse, invention Group I drawn to the product, a polishing pad. Applicants note that, if and when a product claim of elected Group I is found allowable, the nonelected method claims of Group II that depend from or otherwise include all of the limitations of the allowable product claim should be rejoined and considered. M.P.E.P. § 821.04.

The M.P.E.P. recites the requirements for a proper restriction requirement. In particular, the M.P.E.P. states that there are two criteria for proper restriction between patentably distinct inventions: (a) the inventions must be independent, *and* (b) there must be a serious burden on the examiner in the absence of restriction. See M.P.E.P. § 803. These are two separate criteria that must be satisfied to support a proper restriction requirement. The fact that both criteria must be satisfied is made all the more clear by the following statement in the M.P.E.P.: “If the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions.” M.P.E.P. § 803 (*emphasis added*). Thus, if the subject matter of the pending claims is such that there would be no serious burden on the Examiner to search and examine all of the pending claims at the same time, the Examiner is to do so, even if the pending claims are drawn to independent or distinct inventions.

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With respect to the present application and the outstanding restriction requirement, applicants submit that the inventions of Group I and Group II are so related that there will be no serious burden on the Examiner to search and examine all of the subject matter defined by the pending claims at the same time. The Office Action asserts that the apparatus in this invention can be used to practice another and materially different process such as one that requires gas filled pores or no pores. However, claim 1, in Group I, clearly recites in the body of the claim a chemical-mechanical polishing pad comprising a polymeric material and a component selected from solid or liquid or a mixture thereof, wherein the polymeric material has pores and the component material is disposed within the pores. Claim 34 in Group II is drawn to a method of polishing a substrate using the pad of claim 1. Claim 38, also in Group II, is drawn to a method of producing a chemical-mechanical polishing pad comprising; producing a polymeric material comprising component-filled pores, said component selected from a liquid, a solid or a mixture of both. Therefore, claims 34 and 38 exclude the use of gas filled pores or no pores. If claim 1 defines patentable subject matter in view of the prior art, then claims 34-51 necessarily do so as well. Thus, there is significant overlap between the methods of using and producing the pad as defined by the claims of Group II and the pad as defined by the claims of Group I.

In view of the foregoing remarks, applicants respectfully request withdrawal of the restriction requirement, such that all of the subject matter encompassed by the pending claims is considered at the same time.

If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

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